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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/781,851

02/12/2001

Michael Wengrovitz

40538/SAH/X2

7730

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7590

09/09/2004

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EXAMINER

SHAH, CHIRAG G

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 09/781,851	<b>Applicant(s)</b> WENGROVITZ, MICHAEL	
	<b>Examiner</b> Chirag G Shah	<b>Art Unit</b> 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4, 8</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-10, 12-16, 18-22, 24-28, 30-34, and 36-43 rejected under 35 U.S.C. 102(e) as being anticipated by Gallant et al. (U.S. Patent No. 6,636,596), hereinafter, Gallant.

Referring to claims 1 and 7, Gallant discloses in figures 1 and 2 a method for establishing telephonic communication between a first device 13a and a second device 13b over a communication network adhering to a session initiation protocol (SIP), the method comprising:

receiving a first call establishment message from the first device in a SIP-unobservant/SIP-observant format [see in figure 1, 2, column 2, lines 26-65, column 3, lines 39 to column 4, lines 28; traditional telephones 13 are connected to Internet 17 through traditional telephone switching equipment, such as PBXs 19; IP telephony gateways 21 include a signaling gateway and a media gateway. The signaling gateway provides bi-directional translation between PSTN telephony signaling, such as SS7, messages and IP telephony signaling messages in protocols such as H.323 or SIP.

Typically, media gateway use one IP signaling protocol or the other, but not both; the PBX 19a sends a setup message 33 to the IP telephony gateway 21a];

generating a second call establishment message in a SIP-observant format/SIP-unobservant in response to the first call establishment message [see figures 1, 2, column 2, lines 26-65, column 3, lines 39 to column 4, lines 28; The IP telephony gateway 21a maps the setup message 33 into a SIP invite request 35 addressed to the SIP proxy server 23];

transmitting the second call establishment message to the second device over the communication network [as disclosed in column 3, lines 39 to column 4, lines 28; if the SIP proxy server 23 is unable by itself to process setup for a VNET call, the SIP proxy server 23 sends a SIP invite request 37 to the dialed number at the location manager 31] as claim.

Referring to claims 13 and 19, Gallant discloses in figures 1 and 2 of a communication network adhering to a session initiation protocol (SIP) for establishing telephonic communication between devices, the network comprising:

a SIP-unobservant device [figures 1, index 13];

a SIP-observant device [figure 1, index 15]; and

an emulation client operative (27 call control entity of figure 1) between the SIP-unobservant device 13 and the SIP-observant device 15, characterized in that a call establishment message transmitted by the SIP-unobservant device in a SIP-unobservant format is converted to a SIP-observant format by the emulation client and transmitted to the SIP-observant device or vice versa [as disclosed in figures 1, 2 and column 2, lines 26-65, column 3, lines 39 to column 4, lines 28] as claim.

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Referring to claims 25 and 31, Gallant discloses of an emulation client [27 call control entity of figure 1] in a communication network adhering to a session initiation protocol (SIP) for establishing telephonic communication between a SIP-observant [15a] device and a SIP-unobservant [13] device, characterized in that a call establishment message transmitted by the SIP-observant device in a SIP-observant format is converted to a SIP-unobservant format by the emulation client and transmitted to the SIP-unobservant device and vice-versa [as disclosed figures 1, 2 and column 2, lines 26-65, column 3, lines 39 to column 4, lines 28] as claim.

Referring to claims 37 and 39, Gallant discloses in figures 1 and 2 of a method for establishing telephonic communication over a communication network, the method comprising the steps of:

a SIP stack for generating on a SIP-observant device a Session Initiation Protocol (SIP) INVITE message, the SIP INVITE message including a telephone number of a SIP-unobservant device [see figures 1, 2, column 2, lines 26-65, column 3, lines 39 to column 4, lines 28; The IP telephony gateway 21 maps the set up message 33 into a SIP invite request 35 addressed to the SIP proxy server 23]; and

an interface for transmitting by the SIP-observant device on the communication network the SIP INVITE message, wherein response the transmission an emulator operative between the SIP-observant device and the SIP-unobservant device receives a SIP INVITE message including the telephone number of the SIP-unobservant device, converts the SIP INVITE message into a SIP-unobservant format and transmits the message to the SIP-unobservant device [as disclosed in figures 1, 2, column 2, lines 26-65, column 3, lines 39 to column 4, lines 28 and claim 20; the SIP proxy server 23 sends

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a SIP invite request 37 to the dialed number at the location manger 31; upon receipt of the invite request 37, the location manager queries the service control entity 29 with a routing request 39. The service control entity 29 performs a data lookup and responds to the location manager 21 with a routing response 41; the response 43 provides the SIP proxy server 23 with an IP address for the called party at the egress IP telephony gateway 21b, accordingly the SIP proxy server sends an invite request 45 to the called party at the egress IP telephony gateway 21b; upon receipt of the invite 45, the egress IP telephony gateway 21b sends a setup message 47 to the PBX 19b] as claim.

Referring to claim 41, Gallant discloses in figures 1 and 2 of a method for relaying call establishment messages between at least three communication networks, the three networks including a SIP-unobservant network (IP phones 15a, 15b) and a plurality of SIP-unobservant networks (Telephones 13a, 13b), the method comprising steps of:

receiving a plurality of SIP-observant call establishment messages [as disclosed in figures 1, 2, column 2, lines 26-65, column 3, lines 39 to column 4, lines 28; call control entity 27 receives call establishment messages];

translating a first message within the plurality into a first protocol type of a first SIP-unobservant communication network and transmitting the first message on the first SIP-unobservant communication network [as disclosed figures 1, 2, column 2, lines 26-65, column 3, lines 1 to column 4, lines 28, claims 20, 21; receiving an IP telephony session initiation request to a called party at an IP telephony server and sending an intelligent network service control query to legacy SCP in response to receiving the IP telephony session initiation request at a location manager and sending an IP control message to the IP telephony proxy server in response to the query]; and

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translating a second message within the plurality into a second protocol type of a second SIP-unobservant communication network and transmitting the second message on the second SIP-unobservant communication network [as disclosed figures 1, 2, column 2, lines 26-65, column 3, lines 1 to column 4, lines 28, claims 20, 21; receiving an IP telephony session initiation request to a called party at an IP telephony server and sending an intelligent network service control query to legacy SCP in response to receiving the IP telephony session initiation request at a location manager and sending an IP control message to the IP telephony proxy server in response to the query];

wherein the first and second protocol types are different [first may be SS7 and second may be another PSTN telephony signaling as disclosed in col. 2, lines 26-65] as claim.

Referring to claims 2, 8, 14, 20, 26 and 32, wherein the call establishment message is selected from a group consisting of requests, responses, and confirmations [as disclosed in figure 2].

Referring to claims 3, 9, 15, 21, 27, 33, 38, 40, and 43, wherein the SIP-unobservant format adheres to a private branch exchange signaling protocol [as disclosed in figure 1, telephone 13a adheres to PBX 19a].

Referring to claims 4, 10, 16, 22, 28 and 34, further comprising: retrieving redirection information associated with the first call establishment message from a location database [as disclosed in figures 1, 2 and column 3, lines 39 to column 4, lines 28, upon receipt of the invite request 37 the location manager 31 queries the service control entity 29 with a routing request 39, the service control entity 29 performs a data lookup and responds to the location manager 31 with a routing response 41. The location

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manager 31 maps response 41 into a SEP temporarily moved response 43 directed back to SIP proxy server 23]; and redirecting the second call establishment message response to the retrieved redirection information [as disclosed in figures 1, 2 and column 3, lines 39 to column 4, lines 28, the response 43 provides the SIP proxy server 23 with an IP address for the called party at the egress IP telephony gateway 21b, accordingly the SIP proxy server 23 sends an invite request 45 to the called party at the egress IP telephony gateway 21b] as claim.

Referring to claim 6, 12, 18, 24, 30 and 36, further comprising selecting the SIP-unobservant format from a plurality available formats [as disclosed in column 2, lines 26-50 of SS7 and IP telephony signaling messages].

Referring to claim 42, Gallant discloses of further comprising the steps of determining the first protocol type based on a first address in the first message, and determining the second protocol type based on a second address in the second message [as disclosed in column 3, lines 1-30; ] as claim.

3. Claims 13, 19, 25 and 31 rejected under 35 U.S.C. 102(e) as being anticipated by Salama et al. (U.S. Patent No. 6,584,093), hereinafter, Salama.

Referring to claims 13 and 19, Salama discloses in prior art figures 11-13 of a communication network adhering to a session initiation protocol (SIP) for establishing telephonic communication between devices, the network comprising:

a SIP-unobservant device [figure 11, telephone 1112];

a SIP-observant device [figure 11, SIP terminal 1122]; and



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an emulation client operative between the SIP-unobservant device and the SIP-observant device, characterized in that a call establishment message transmitted by the SIP-unobservant device in a SIP- unobservant format is converted to a SIP-observant format by the emulation client and transmitted to the SIP-observant device or vice versa [as disclosed in figure 11-13 and column 6, lines 17-46 of SIP/PSTN Gateway 1116 which routes the call through Internet 1130 to a SIP terminal (SIP observant format); figures 7 and 8 include conversion from SIP observant format to a SIP unobservant format] as claim.

Referring to claims 25 and 31, Salama discloses of an emulation client [SIP/PSTN Gateway 1116 of figures 11] in a communication network adhering to a session initiation protocol (SIP) for establishing telephonic communication between a SIP-observant [SIP terminal 1122 of figure 11] device and a SIP-unobservant [Telephone 1112 of figure 11] device, characterized in that a call establishment message transmitted by the SIP-observant device in a SIP-observant format is converted to a SIP-unobservant format by the emulation client and transmitted to the SIP-unobservant device and vice-versa [as disclosed in figure 11-13 and column 6, lines 17-46 of SIP/PSTN Gateway 1116 which routes the call through Internet 1130 to a SIP terminal (SIP observant format); figures 7 and 8 include conversion from SIP observant format to a SIP unobservant format] as claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 11, 17, 23, 29, and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant in view of Maggenti et al (U.S. Patent No. 6,477,150).

Referring to claim 5, 11, 17, 23, 29 and 35, Gallant discloses in figure 1 and column 3, lines 8 to 30 of the location manager 31 functioning as a SIP redirect server. Gallant however fails to explicitly disclose that the redirection information is associated with a day and a time indicative of when the call establishment message is to be redirected. Maggenti discloses in figure 7 may redirect SIP request using SIP redirection mechanism associated with a time for redirection. Therefore, it would have been obvious to one of ordinary skill in the art to include the feature as taught by Maggenti into the SIP redirect server of Gallant in order to facilitate and integrated service while reducing delay.

***Conclusion***

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
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**Or faxed to:**

(703)305-3988, (for formal communications intended for entry)

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**Or:**

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Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal  
Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Chirag G Shah whose telephone number is 703-305-5639.

The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for  
the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the  
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Center (EBC) at 866-217-9197 (toll-free).

  
**Ajit Patel**  
**Primary Examiner**

cgs  
August 24, 2004